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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Fits Corporation K.K.

Serial No. 76501790

Marilyn Matthes Brogan of Frommer Lawrence & Haug LLP for
Fits Corporation K.K.

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(K. Margaret Le, Managing Attorney).

Before Bucher, Drost, and Kuhlke, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On March 21, 2003, Fits Corporation K.K. (applicant)
applied to register the mark LOVE PASSPORT in standard
character form on the Principal Register for "cosmetics;
toiletries, namely, perfumes, cologne, shower gel, body
milk, shampoo, [and] hair rinse" in Class 3.¹

¹ Serial No. 76501790. The application is based on an intent to
use the mark in commerce as well as the ownership of Japanese
Registration No. 4662728.

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of a prior registration for the mark PASSPORT in standard character form for "perfume and cologne" in Class 3.² The examining attorney's position is that the goods are identical and highly related and that "the wording LOVE does not distract from the more dominant wording PASSPORT when considering the general commercial impression of the respective marks." Brief at 3.

Applicant maintains (Brief at 5) that:

[T]he composite "love passport" might inspire one to think of a journey toward happiness, love or fulfillment. This is different from the word "passport" alone, which simply has a utilitarian concept and meaning and would not generally be linked together with the word "love," as is the case in the instant composition. Thus, the presence of the word "love" in the instant mark creates a situation where the marks in question do not have the same connotation.

After the examining attorney made the refusal final, applicant filed this appeal.

When there is a question of likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I.

² Registration No. 2,279,592, issued September 21, 1999. At present, a Section 8 affidavit has not been filed.

du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We start by comparing the goods. In this case, the goods in the application and registration are identical to the extent that both identification of goods include perfume and cologne. If the involved marks are used on identical goods, there is a greater likelihood that when similar marks are used in this situation, confusion would be likely. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) ("When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines"). In addition, we must assume that identical goods travel through the same channels of trade and that the potential purchasers are the same. In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994).

Another important factor we consider is a comparison of the marks as to the "similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression." Majestic Distilling, 65 USPQ2d at 1203. It is well settled that it is improper to dissect a mark and that marks must be viewed in their entireties. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). However, "more or less weight may be given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (footnotes omitted).

In this case, the marks are PASSPORT and LOVE PASSPORT. Both marks are shown in typed or standard character form so there is no difference in the style of the marks. The marks are similar to the extent that they contain the identical word PASSPORT and different because applicant's mark adds the word LOVE. While these marks are not identical, their pronunciation and appearance would not be dissimilar.

In addition, we look at the meaning and connotation of the marks PASSPORT and LOVE PASSPORT. A "passport" is

defined as "an official document that identifies a person as a citizen of a country and permits that person to travel abroad" and "something that assures the achievement of something else: *Hard work is often a passport to success.*" *The American Heritage Student Dictionary* (1998).³ In the marks, the term "passport" would likely have the same meaning, i.e., "something that assures the achievement of something else." The "something else" in applicant's case is explicitly identified as "love."

Also, the connotation of the marks is similar. Applicant argues, without any evidentiary support, that "'love' is such a strong and dominant word, even more dominant serving as the first portion of the mark, that the addition of this word does indeed create a different impression from the word 'passport' alone." Brief at 3. However, "Perfume" is "a substance, extract, or preparation for diffusing or imparting an agreeable or attractive smell." *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987). Obviously, perfume as an attractive scent can be used to appeal to members of the opposite sex for the purpose of romance or love. The use

³ We take judicial notice of dictionary definitions. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

of "Love" on such a product would hardly seem unusual. Therefore, LOVE PASSPORT and PASSPORT, when used on perfume and similar products, would have the same connotation because both would suggest that the perfume is a passport to love or romance. The term "Passport" would be the dominant part of both marks because, in registrant's mark, it is the only term and, in applicant's mark, the additional word "Love" merely identifies more specifically the goal or destination of the "Passport."

Applicant argues that its contention that there is no confusion "is supported by another factor, i.e., the existence of third-party marks which contain the formative 'passport' which co-exist on the Principal Register." Brief at 4. However, applicant's evidence to support this argument is only a list that includes the serial and registration number and the word mark. While the examining attorney has objected to this evidence on the ground that it was not timely submitted (Brief at n.3), inasmuch as applicant submitted this evidence with its request for reconsideration, it is timely. However, the examining attorney has also objected to this evidence because no actual printouts of registration were submitted. We agree that a simple list of trademarks with their serial and registration numbers is not probative evidence. In re

Duofold, Inc., 184 USPQ 638, 640 (TTAB 1974) ("[T]he submission of a list of registrations is insufficient to make them of record"). We also agree that while third-party registrations may be used to demonstrate that a portion of a mark is suggestive or descriptive, they cannot be used to justify the registration of another confusingly similar mark. In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987). Therefore, this list does not support applicant's argument that there is not a likelihood of confusion.

In addition, applicant has submitted copies of two applications. The first (Serial No. 78119551) is for the mark THE GOLDEN DOLPHIN SPA YOUR PASSPORT TO PARADISE and design for "toiletries, specifically, skin care lotions oils and soaps, aromatherapy oils, tanning lotions and oils." The second (Serial No. 78162758) is for the mark PASSPORT TO LOVE for, inter alia, perfume, but this application is now abandoned. An abandoned application and a pending application for a very different mark hardly support applicant's position. Our principal reviewing court has commented on the use of third-party registrations: "Much of the undisputed record evidence relates to third party registrations, which admittedly are given little weight but which nevertheless are relevant

when evaluating likelihood of confusion. As to strength of a mark, however, registration evidence may not be given any weight." Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (emphasis in original). See also AMF Inc. v. American Leisure Prods., Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973) ("The existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them").

Therefore, when we compare the marks in their entirety, we find that, while they are not identical to the extent that applicant includes the word "Love," their meaning and connotation would be very similar and their appearance and pronunciation would not be dissimilar. See, e.g., Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products); In re Chatam International Inc., 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) ("With respect to JOSE, the Board correctly observed that the term simply reinforces the impression that GASPAR is an individual's name. Thus, in accord with considerable case law, the JOSE term does not alter the commercial impression of the mark."

The marks JOSE GASPAR GOLD and GASPAR'S ALE were determined to be similar).

Applicant relies on the following cases: Colgate-Palmolive Co. v. Carter-Wallace, Inc., 432 F.2d 1400, 167 USPQ 529 (CCPA 1970) (PEAK PERIOD for deodorants and PEAK for dentifrice not confusingly similar) and Lever Brothers Co. v. Barcolene Co., 463 F.2d 1107, 174 USPQ 392 (CCPA 1972) (ALL CLEAR! not confusingly similar to ALL for household cleaners). However, in the Colgate-Palmolive case, not only did the marks create different impressions (PEAK and PEAK PERIOD) but the goods were substantially different. In the Lever Brothers case, the mark ALL CLEAR!, with its connotation of air raids was substantially different from the mark ALL.

In the instant case, we conclude that confusion is likely if the marks LOVE PASSPORT and PASSPORT were both used on perfume and cologne.

Decision: The examining attorney's refusal to register applicant's mark under Section 2(d) of the Trademark Act is affirmed.